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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,169	12/22/2003	Iwan Wolf	DT-6695	7756
30377	7590	04/21/2005		
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			EXAMINER DURAND, PAUL R	
			ART UNIT 3721	PAPER NUMBER

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)
	10/743,169	WOLF ET AL.
	Examiner	Art Unit
	Paul Durand	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to. ~
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 December 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Patton et al (US 2002/0158102).

In regard to claim 1, Patton discloses the invention as claimed including housing 10, a chamber capable of combustion (number not shown, but within head 11), piston guide in the form of a chamber, (number not shown, but within head 11), piston (number not shown, but within head 11), which is displaceable under an expanding gas and electrically powered compressor 130 (see Figs. 1,2,7,8 and Pgs. 4-8).

In regard to claims 2 and 3, Patton discloses the invention as claimed including an electrically driven compressor, which compresses the driving gas.

In regard to claims 4 and 5, Patton discloses the invention as claimed including a storage medium in the form of pressure reservoir 210.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patton in view of Hirai et al (US 6,220,496).

Patton discloses the invention substantially as claimed except for the explicit use of valve assembly and a conduit. However, Hirai teaches that it is old and well known in the art to provide a pressurized storage medium 20, which stores pressurized air, connected to the pre compression device by check valve 22 and a pressure valve 21, which regulates the pressure from the storage to the tool for the purpose of supplying a tool with a high pressure of air (see Fig.1 and C3,L42 – C4,L41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Patton with the valve and conduit means as taught by Hirai for the purpose of supplying a tool with a high pressure of air.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obergfell (US 3,850,359) in view of Patton.

Obergfell discloses the invention substantially as claimed including a combustion powered tool housing , combustion chamber 24, piston guide in the form of cylinder 26, piston 28, and a pre compression device in the form of a compressor 42, which supplies compressed air to the tool (see Figs. 1,4-6, C3,L1-18 and C6,L9-20). What Obergfell does not disclose is the use of an internal electric compressor to pre compress the gas

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prior to driving the piston . However, Patton teaches that it is old and well known in the art of tool driving to provide a tool, with an electrically powered compressor 130 inside housing 10 for the purpose of increasing the portability of a driving tool (see Figs. 1,2,7,8 and Pgs. 4-8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Obergfell with the compressing means as taught by Patton for the purpose of increasing the portability of a driving tool.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsu (US 4,773,581) in view of Patton.

Ohtsu discloses the invention substantially as claimed including a combustion powered tool housing 1, combustion chamber 22, piston guide in the form of cylinder 2, piston 3 and a pre compression means in the form of an air supply device 9, connected to the tool (see Fig.1 and C2,L17 – C3,L25). What Ohtsu does not disclose is the use of an internal electric compressor to pre compress the gas prior to driving the piston . However, Patton teaches that it is old and well known in the art of tool driving to provide a tool, with an electrically powered compressor 130 inside housing 10 for the purpose of increasing the portability of a driving tool (see Figs. 1,2,7,8 and Pgs. 4-8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Ohtsu with the compressing means as taught by Patton for the purpose of increasing the portability of a driving tool.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (US 4,665,868).

Adams discloses the invention substantially as claimed including a combustion powered tool housing 11, combustion chamber 20, piston guide in the form of cylinder 31, piston 33 and a pre compression means in the form of an air supply device 61, internal to the tool, which manually provides pre compressed air to the tool (see Fig. 1 and C1,L51 – C3,L3). What Adams does not disclose is the use of an internal electric compressor to pre compress the gas prior to driving the piston . However, Patton teaches that it is old and well known in the art of tool driving to provide a tool, with an electrically powered compressor 130 inside housing 10 for the purpose of increasing the portability of a driving tool (see Figs. 1,2,7,8 and Pgs. 4-8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Adams with the compressing means as taught by Patton for the purpose of increasing the portability of a driving tool.

8. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obergfell or Ohtsu or Adams in view of Patton and in further view of Hirai.

The modified inventions of Obergfell, Ohtsu and Adams disclose the invention substantially as claimed except for a storage medium separate from the compressing means. However, Hirai teaches that it is old and well known in the art to provide a pressurized storage medium 20, which stores pressurized air, connected to the pre compression device by check valve 22 and a pressure valve 21, which regulates the pressure from the storage to the tool for the purpose of supplying a tool with a high pressure of air (see Fig.1 and C3,L42 – C4,L41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

have provided the modified inventions of Obergfell, Ohtsu and Adams with the separate storage means as taught by Hirai for the purpose of supplying a tool with a high pressure of air.

Response to Arguments

9. Applicant's arguments filed 1/26/2005 have been fully considered but they are not persuasive.

10. Applicant's argues that the prior art reference of Obergfell does not teach the applicants invention in that the pre compressing means is not located within the tool housing. The examiner does not agree with this assertion. First, the examiner argues that Obergfell is silent as to the location of the compressed air source, which is the broadest reasonable interpretation could be integral to the housing. Second, the limitation of the pre compression source appears to be added to the claim in the present amendment. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As a result of the amended claim the newly added references of Patton, Ohtsu and Adams have been used as a basis for the rejection above.

Therefore, for the reasons indicated above, the rejection is deemed proper.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

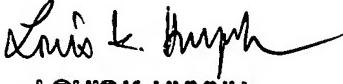
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
April 13, 2005


LOUIS K. HUYNH
PRIMARY EXAMINER